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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,902	12/21/2001	Lisa Baker	PGI6044P0291US	5142

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WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

EXAMINER

STEPHENSONS, JACQUELINE F

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 08/07/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/036,902	BAKER, LISA
	Examiner Jacqueline F Stephens	Art Unit 3/61

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 May 2003.
 - 2a) This action is FINAL. 2b) This action is non-final.
 - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-10 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 - 5) Claim(s) _____ is/are allowed.
 - 6) Claim(s) 1-10 is/are rejected.
 - 7) Claim(s) _____ is/are objected to.
 - 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 December 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/16/03 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the odor control composition can be either topically applied to or incorporated in a base substrate material of a hygiene product) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Independent claim 1 requires an odor controlling composition comprising an hydroxydiphenyl ether in a modified acid carrier provided on a base substrate material of a disposable hygiene product. Given the broadest reasonable interpretation, the examiner construes the claim to encompass an odor controlling composition that is present in any manner, i.e. coating, immediately adjacent to, or incorporated into the substrate itself. The substrate being any layer of the disposable hygiene product, topsheet, backsheets, core, or intervening layers. Nakamura, on page 6, lines 20-21, teaches the odor control composition comprises a HFAP and an antimicrobial agent. Nakamura further teaches the odor control composition is attached to the substrate web comprising the absorbent core of an absorbent article (page 18, lines 8-18).

Applicant argues the invention of Nakamura is distinct from the present invention in that Nakamura teaches adherence of the antimicrobial agent to the hydrogel-forming polymeric particles and the combination of antimicrobial/hydrogel-forming polymer and applicant teaches odor control composition, comprising a hydroxydiphenyl ether in a modified acidic carrier provided on a base substrate material of the disposable hygiene product. While Nakamura does teach the combination of antimicrobial/hydrogel-forming polymer, Nakamura teaches this combination disposed on a base substrate material of a disposable hygiene product (page 18, lines 8-18). The 'comprising' language used in the independent claims is inclusive or open-ended and does not exclude additional unrecited elements, compositional components, or steps.

As to applicant's arguments regarding the steps for providing the odor control composition to the base substrate (applicable to claims 6 -8), these arguments are persuasive.

2. Applicant is reminded that a complete response to an Office Action, in accordance with 37 CFR 1.111, includes a response to each rejection. Therefore, applicant is required to respond the provisional double patenting rejection made in the Office Action mailed 2/13/03. A response by filing of a Terminal Disclaimer or a traversal of the rejection is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10036840. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application is claiming an odor control composition in a disposable hygiene product. It is old and well

Art Unit: 3761

known in the art that disposable hygiene products can include diapers, sanitary napkins, training pants, pull-on garments, and incontinence garments.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-4, 9, and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by Nakamura WO 99/38541.

As to claims 1 and 10, Nakamura discloses a composition for controlling odor produced by human waste retained in a disposable hygiene product (page 1, line 34 through page 2, line 15), comprising an hydroxydiphenyl ether in a modified acidic carrier. Nakamura discloses aliphatic acid comprises the hydrogel-forming absorbent polymer carrier (page 8, lines 18-26), and the odor control agent is hydroxydiphenyl ether, which is bonded to the carrier (page 6, lines 29-32). Nakamura teaches this combination disposed on a base substrate material of a disposable hygiene product (page 18, lines 8-18).

In addition, claim 10 recites product-by process limitations regarding the application of the admixture to the base substrate. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113. Nakamura structurally anticipates claim 10 in that Nakamura provides an odor controlling composition comprising an admixture of hydroxydiphenyl ether and a modified acidic carrier attached to a base substrate material as described above.

As to claim 2, Nakamura discloses the hydroxydiphenyl ether is a trichlorodiphenyl ether (page 14, lines 28-34).

As to claims 3 and 4, Nakamura discloses the modified acidic carrier is an organic acid, such as aliphatic acid (page 6, lines 29-32, page 8, lines 18-26).

Regarding claim 9, Nakamura discloses a composition for controlling odor wherein the composition is provided on a base substrate (page 8, lines 8-18). The method of providing the composition is directed to a product by process. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not

depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113. Nakamura structurally anticipates claim 9 in that Nakamura provides an odor controlling composition comprising an admixture of hydroxydiphenyl ether and a modified acidic carrier attached to a base substrate material.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Beall et al. USPN 6287634. Nakamura discloses the present invention substantially as claimed. However, Nakamura does not disclose the aliphatic acid is a hexanedioic acid. Beall discloses the use of hexanedioic acid in a topical treatment compound (col. 12, lines 20-21 and col. 22, lines 53 through col. 23, line 16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate hexanedioic acid in the invention of Nakamura as taught in Beall. Doing so would provide a compound that can be combined with a

Art Unit: 3761

topically- active compound and homogeneously dispersed as an insoluble, particulate material in order to deliver a topical treatment, to be delivered to the skin, which Beall teaches is desired (col. 22, lines 53-67).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for After Final communications.

Application/Control Number: 10/036,902
Art Unit: 3761

Page 9

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Jacqueline F Stephens
Examiner
Art Unit 3761

August 5, 2003


WEILUN LO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700